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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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JAY H. MAIOLI Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			EXAMINER	
			LE, MIRANDA	
			ART UNIT	PAPER NUMBER
			2177	
			DATE MAILED: 07/11/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
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	Office Action Summary	09/809,668 Examiner	TERAYAMA ET AL.  Art Unit.
	,		
	- The MAILING DATE of this communica	Miranda Le	with the correspondence address
Period for	Reply	don appears on the cover sneet	with the correspondence address
THE N - Extens after S - If the p - If NO p - Failure - Any re	PRTENED STATUTORY PERIOD FOR IAILING DATE OF THIS COMMUNICAtions of time may be available under the provisions of 3 (1X (6) MONTHS from the mailing date of this communication of reply specified above is less than thirty (30) deperiod for reply is specified above, the maximum statute to reply within the set or extended period for reply will, ply received by the Office later than three months after patent term adjustment. See 37 CFR 1.704(b).	ATION.  17 CFR 1.136(a). In no event, however, may cation.  ays, a reply within the statutory minimum of pry period will apply and will expire SIX (6) Modes to be statute. Cause the application to become	thirty (30) days will be considered timely.
1)	Responsive to communication(s) filed	on <u>15 March 2001</u> .	
2a)	This action is <b>FINAL</b> . 2b)	☐ This action is non-final.	
3)	Since this application is in condition fo	r allowance except for formal n	natters, prosecution as to the merits is
	closed in accordance with the practice on of Claims		C.D. 11, 453 O.G. 213.
	Claim(s) <u>128</u> is/are pending in the app		
	a) Of the above claim(s) is/are v	withdrawn from consideration.	,
5) 🗌 (	Claim(s) is/are allowed.		
6)⊠ (	Claim(s) <u>1-28</u> is/are rejected.	•	
7) 🗌 (	Claim(s) is/are objected to.		
	Claim(s) are subject to restriction n Papers	n and/or election requirement.	
9)[] T	he specification is objected to by the E	xaminer.	
10)[] T	ne drawing(s) filed on is/are: a)[	accepted or b) objected to by	y the Examiner.
	Applicant may not request that any objecti	on to the drawing(s) be held in abo	eyance. See 37 CFR 1.85(a).
11) 🗌 Ti	ne proposed drawing correction filed or	n is: a)  approved b)	disapproved by the Examiner.
<b>L</b>	If approved, corrected drawings are require	• •	
12)∐ TI	ne oath or declaration is objected to by	the Examiner.	•
riority un	der 35 U.S.C. §§ 119 and 120		
13)⊠ <i>A</i>	acknowledgment is made of a claim for	foreign priority under 35 U.S.C	c. § 119(a)-(d) or (f).
a)⊠	All b) Some * c) None of:		
1	. Certified copies of the priority doc	cuments have been received.	
2	. Certified copies of the priority doc	cuments have been received in	Application No
	. Copies of the certified copies of the application from the Internation the attached detailed Office action for	onal Bureau (PCT Rule 17:2(a))	).
14) 🗌 Ac	knowledgment is made of a claim for d	omestic priority under 35 U.S.C	C. § 119(e) (to a provisional application)
	The translation of the foreign languars. The translation of the foreign languars are the translations and the translations are the translations.		
ttachment(s		-	-
) 🔯 Notice	of References Cited (PTO-892) of Draftsperson's Patent Drawing Review (PTO- ition Disclosure Statement(s) (PTO-1449) Paper	948) 5) Notice (	w Summary (PTO-413) Paper No(s) of Informal Patent Application (PTO-152)
Patent and Trad		Office Action Summary	Part of Paper No. 6

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### **DETAILED ACTION**

#### Claim Objections

1. Claim 12 is objected to because of the following informalities: "a extractor" should be changed to "an extractor". Appropriate correction is required.

#### **Priority**

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

## Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless:

- (e) the invention was described in
- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 4. Claims 12-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Blonder et al. (US Patent No. 6,098,085).

Blonder anticipated independent claim 12, by the following:

As per claim 12, Blonder teaches "a file storage means for storing the file" at col. 4, lines 16-63;

"a detector means for detecting the identifier which indicates the data displayable on a limited-capability device from the file stored in said first file storage means" at col. 8, lines 10-17;

"a extractor means for extracting, from said first file, the data with the start and the end thereof indicated, in accordance with the identifier detected by the detector means" at col. 6, lines 1-14, col. 8, line 44 to col. 9, line 12;

"an output means for outputting the extracted data to the limited-capability device" at col. 13, lines 11-25;

"a control means for controlling the detector means to detect the identifier indicating the start and the end of the displayable data for the purpose of extracting the data displayable on the limited-capability device from said first file stored in said file storage means, for controlling said extractor means to extract, as a new output file, data including the start and the end indicated by the identifier from said first file, and for controlling said output means to output the new output file to the limited-capability device" at col. 8, lines 10-17, col. 13, lines 11-25, col. 5, line 52 to col. 6, line 14.

As per claim 13, Blonder teaches "an extracted data storage means for storing the extracted data as candidate data to be output to the limited-capability device" at col. 6, lines 1-14, col. 8, line 44 to col. 9, line 12.

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As per claim 14, Blonder teaches "the data converter selectively outputs the data from among data stored in said extracted data storage means to the limited capability device in response to an instruction of a user" at col. 16, line 20 to col. 17, line 11.

As per claim 15, Blonder teaches "an image converter means for converting an image file indicated by said first file into data displayable on the limited-capability device" at col. 7, lines 19-28.

As per claim 16, Blonder teaches "a rule file storage means for storing a conversion rule file for converting said image file into an image file displayable on the limited-capability device" at col. 7, lines 19-28,

wherein said image converter means performs image conversion based on data indicating a screen size of the limited-capability device included in said conversion rule file" at col. 12, lines 66-67.

As per claim 17, Blonder teaches "a display data output means for converting said first file into a data format displayable on the limited-capability device for displaying said first file, wherein the data converter acquires a file which is converted to be output to the limited-capability device from a file buffer means which buffers at least one file of the display data output means" at col. 5, lines 52-67.

As per claim 18, Blonder teaches "a data communication means for acquiring the file through a communication network" at col. 7, line 19 to col. 8, line 3.

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As per claim 19, Blonder teaches "the data converter restricts, to the limited-capability device, the outputting of data not displayable on the limited-capability device, from among data from the start to the end indicated by the extracted identifier" at col. 16, line 20 to col. 17, line 11.

### Claim Rejections - 35 USC § 103

- 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blonder et al. (US Patent No. 6,098,085), in view of Grossweiler; III et al. (US Patent No. 6,573,916 B1).

As per claim 1, Blonder teaches "a step of detecting the identifier by reading the file" at col. 5, line 52 to col. 6, line 14, at col. 8, lines 10-17;

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"a step of extracting the data, the start and the end of which are indicated by the determined identifier and which is determined to be displayable on the limited-capability device" at col. 6, lines 1-14, col. 8, line 44 to col. 9, line 12;

"a step of outputting an output file which is newly created from the extracted data, as a different file from the first file" at col. 13, lines 11-25.

Blonder does not expressly teach "a step of determining whether the data indicated by the detected identifier is displayable on the limited-capability device". However, Grossweiler teaches this limitation at col. 6, lines 19-41.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Blonder with the teachings of Grossweiler to include "a step of determining whether the data indicated by the detected identifier is displayable on the limited-capability device" in order to provide a method of operating a computing system that includes a display for rendered graphical images and an electronic tag reader configured to read are identifier of the electronic tag providing signals indicating target regions within images presented by the display.

As per claim 2, Blonder teaches "the step of extracting the data is performed by referencing a conversion definition file that defines the identifier of the data that is displayable on the limited-capability device" at col. 9, lines 28-38, col. 10, lines 8-57.

As per claim 3, Blonder teaches "the conversion definition file includes a rule for converting an image data file, and wherein the file conversion method comprises a step of

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outputting, to the limited-capability device, the image data file which has been converted based on the conversion rule of the image data file" at col. 12, line 66 to col. 13, line 3, Fig. 10.

As per claim 4, Blonder teaches "the conversion definition file includes information of an image size displayable on the limited-capability device" at col. 7, lines 19-28.

As per claim 5, Blonder teaches "the file comprises category information, and wherein the file conversion method comprises a step of selecting the conversion definition file to be used, based on the category information of the file among a plurality of conversion definition files" at col. 4, lines 32-48.

As per claim 6, Blonder teaches "a file name of a file output as a new file uses a symbol string indicated by the predetermined identifier" at col. 12, lines 17-28.

As per claim 7, Blonder teaches "a step of selecting a file to be output to the limited-capability device from among the extracted data in response to an instruction from a user" at col. 16, line 20 to col. 17, line 11.

As per claim 8, Blonder teaches "a step of acquiring the first file through a communication network from a data storage apparatus" at col. 7, line 19 to col. 8, line 3.

As per claim 9, Blonder teaches "the step of extracting the data comprises initializing a data buffer" at col. 5, lines 52-67, col. 8, lines 17-24,

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"and buffering in the data buffer the data included in the first file, the start and the end of which are .indicated by the detected identifiers" at col. 5, lines 52-67.

As per claim 10, Blonder teaches "the outputting of the data, the start and the end of which are indicated by the identifiers, to the limited-capability device is restricted in accordance with the identifiers" at col. 12, lines 17-65.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blonder et al. (US Patent No. 6,098,085), in view of Grossweiler; III et al. (US Patent No. 6,573,916 B1), and further in view of Serbinis et al. (US Patent No. 6,584,466 B1).

As per claim 11, Blonder teaches "the expiration date of the data, the start and the end of which are indicated by the identifiers, is indicated by the identifiers" at col. 6, lines 1-14.

Blonder, however, does not expressly teach "the expiration date of the data". However, Serbinis teaches this limitation at col. 9, lines 21-33.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Blonder, Grossweiler with the teachings of Serbinis to include "the expiration date of the data" in order to provide users a plurality of document management services, including document storage and retrieval, collaborative file sharing and workflow services for electronic documents, an electronic document delivery service, and a document distribution service.

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8. Claims 20-21, 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blonder et al. (US Patent No. 6,098,085), in view of Serbinis et al. (US Patent No. 6,584,466 B1).

As per claim 24, Blonder teaches "a storage means for: storing the file input thereto" at col. 4, lines 16-63;

"a detector means for detecting an identifier which indicates the data, which is processable by the second apparatus, from the file stored in the storage means" at col. 8, lines 10-17;

"an extractor means for extracting, from the input file, the data which is detected by the detector means and is processed into data processable by the second apparatus" at col. 6, lines 1-14, col. 8, line 44 to col. 9, line 12;

Blonder does not expressly teach the following limitations. However, Serbinis teaches:

"a processing means for processing the extracted data into the data that is processable by the second apparatus" at Fig. 1A;

"an output means for outputting the data, which has been processed to be processable by the second apparatus, to the second apparatus" at col. 4, lines 41-61, col. 9, lines 33-49;

"a control means for controlling the storage means to store the file input thereto in the storage means, for controlling the detector means to detect the identifier that indicates, from the file stored in the storage means, data that can be processed to be processable by the second apparatus, for controlling the extractor means to extract: the data that is processed by the processing means in accordance with the identifier detected by the detector means, and for

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controlling the output means to output the data that has been processed by the processing means" at col. 4, lines 41-61, Fig. 1A;

"wherein the second apparatus comprises: a receiver means for receiving the data output by the first apparatus" at col. 4, lines 41-61, col. 9, lines 33-49;

"a display means for displaying the data received by the receiver means" at col. 4, lines 41-61, col. 9, lines 33-49.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Blonder with the teachings of Serbinis to include "a processing...an output...a control means...data that can be processable by the second apparatus" in order to provide users a plurality of document management services, including document storage and retrieval, collaborative file sharing and workflow services for electronic documents, an electronic document delivery service, and a document distribution service.

As per claim 25, Blonder teaches "the first apparatus further comprises a receiver means, and wherein the receiver means receives the file from a file server connected to the receiver means via a network" at col. 7, line 19 to col. 8, line 3.

As per claim 26, Blonder teaches "a buffer means for buffering the data extracted from the file by the control means, and wherein the control means controls the buffer means to buffer the extracted data while processing the data buffered in the buffer means" at col. 8, lines 17-23.

As per claim 27, Blonder teaches "the first apparatus further comprises an operation means operated by a user" at col. 7, lines 1-11, col. 16, lines 20-67,

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Serbinis teaches "and wherein the control means outputs the data, designated on the operation means by the user, to the second apparatus" at col. 4, lines 41-61, Fig. 1A.

As per claim 28, Serbinis teaches "an operation means operated by a user" at col. 4, lines 41-61, col. 9, lines 33-49, col. 12, lines 24-59;

"and a storage means for storing the data received by the receiver means" at col. 5, lines 36-62,

"wherein the data designated on the operation means by the user is read from the storage means and is displayed on the display means" at col. 4, line 41 to col. 5, line 62.

As per claim 20, Blonder does not explicitly teach "an expiration date extractor means for extracting, from the identifier, expiration date data indicating the expiration date of the data extracted by the identifier; and an expiration date determination means for determining the expiration date of the extracted data based on the expiration date of the extracted data". However, Serbinis teaches this limitation at col. 9, lines 21-33.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Blonder with the teachings of Serbinis to include "an expiration date extractor means for extracting, from the identifier, expiration date data indicating the expiration date of the data extracted by the identifier; and an expiration date determination means for determining the expiration date of the extracted data based on the expiration date of the extracted data" in order to provide users a plurality of document management services, including document storage and retrieval, collaborative file sharing and workflow services for

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electronic documents, an electronic document delivery service, and a document distribution service.

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As per claim 21, Blonder does not specifically teach "a data renewal means for renewing the expiration date of the extracted data when it is determined that the extracted data has expired". However, Serbinis teaches this limitation at col. 9, lines 21-33.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Blonder with the teachings of Serbinis to include "a data renewal means for renewing the expiration date of the extracted data when it is determined that the extracted data has expired" in order to provide a system that enable detailed accounting of transactions occurring on the system, and a customization function that permits multiple service providers to utilize the common document management services of a server, while presenting end-user with distinct dedicated websites.

Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blonder et 9. al. (US Patent No. 6,098,085).

As per claim 22, Blonder teaches "a step of initializing a first data buffer for buffering data when a plurality of pieces of data is read from the file" at col. 8, lines 10-36;

"a step of detecting the identifier indicating the start of the data in the file, based on a rule for processing the data in the file into a data format displayable on the limited capability device, when the data is from the file and is stored in the first data buffer" at col. 8, lines 10-17, col. 6, lines 15-31;

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"a step of detecting the identifier indicating the end of the data in response to the identifier indicating the end of the detected data" at col. 8, lines 10-17, col. 6, lines 15-31;

"a step of holding the data in the file, from the start thereof, into the first data buffer, based on the identifier indicating the start of the detected data" at col. 5, line 52 to col. 6, line 14.

Blonder does not specifically teach "a step of moving the data stored in the first data buffer to a second data buffer for evacuation; and a step of moving the data evacuated into the second data buffer to the first data buffer for restoration". However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Blonder's system to include "a step of moving the data stored in the first data buffer to a second data buffer for evacuation; and a step of moving the data evacuated into the second data buffer to the first data buffer for restoration" in order to enable a file conversion method for converting a file composed of a plurality of pieces of data displayable on a display unit into data displayable on a connected limited-capability device.

As per claim 23, Blonder teaches "a step of storing, in a storage means, data from the first data buffer as data to be processed" at col. 5, line 52 to col. 6, line 14;

Blonder does not expressly teach "a step of moving the data evacuated into the second data buffer to the first data buffer for restoration". However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Blonder's system to include "a step of moving the data evacuated into the second data buffer to the first data buffer for restoration" in order to enable a file conversion method for converting a file composed of a

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plurality of pieces of data displayable on a display unit into data displayable on a connected limited-capability device.

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#### Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (703) 305-3203. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached on (703) 305-9790. The fax number to this Art Unit is (703) 746-7238. The TC 2100's Customer Service number is (703) 306-5631.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Miranda Le July 1, 2003

PRIMARY EXAMINER